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09/682,231	08/08/2001	Ruth E. Rosenholtz	110268	9878
27074 7590 05/02/2007 OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER TRAN, QUOC A	
			ART UNIT	PAPER NUMBER
			2176	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27074@oliff.com
jarmstrong@oliff.com

Office Action Summary

Application No.

09/682,231

Applicant(s)

ROSENHOLTZ ET AL.

Examiner

Tran A. Quoc

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

4/25/07

DETAILED ACTION

1. This is a **Final Rejection** in response to the Amendment/Remarks filed on 01-30-2007.
2. Claims 1-8 are pending and rejected in this action.
3. Effective filing date 08-08-2001.
4. Examiner withdrawn the objection to claims 1, 3, 6 and 8 of Office Action dated 12-01-2006.

Double Patenting

5. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. US007069506B2 issued June 27, 2006 [hereinafter “the ’506 patent”]. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both exhibiting similar method of enhance thumbnail associated with a document.

This is an obviousness-type double patenting rejection because “A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ELI LILLY

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AND COMPANY v BARRLABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

“Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent.

Thus, the generic invention is "**anticipated**" by the species of the patented invention. Cf.,

Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting.” (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

Claims 1-8, of current application and U.S. the '506 patent, claims 1 and 6 are compared as follows, showing the obviousness of the teachings of the patent to the claimed invention:

<p>Application 09/682,231 (The present Application)</p>	<p>Patent 7,069,506 B2</p>
<p>Claims 1 and 6</p>	<p>Claims 1-40</p>
<p>A computer-executable method of displaying a document associated with a thumbnail generated based on an original document, comprising:</p> <p>displaying the thumbnail corresponding to an original document and including an enhancement in appearance as displayed on the thumbnail;</p>	<p>A method for generating an enhanced thumbnail associated with a document, comprising: (see claim 20)</p> <p>A renderer that generates a reduced-size representation of the document (see claim 21)</p>

receiving a request to display the original document	A method for generating an enhanced thumbnail associated with a document, comprising: obtaining a document comprising a plurality of elements (see claim 1)
displaying a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document based on comparison of the at least a portion of the first version to the corresponding portion of the original document and the corresponding portion of the thumbnail.	wherein the at least one visible element comprises first and second visible elements, further comprising determining relevance of the first and second elements, the first visible element being determined to have a higher relevance than the second visible element, wherein modifying the appearance of the at least one element comprises modifying the first visible element with a different modification than the second visible element (see claim 10)

In addition, it is obvious that the claimed limitation cites above, receiving a method of presenting a user an enhanced thumbnail associated with a document, wherein displaying a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document based on comparison of the at least a portion of the first version to the corresponding portion of the original document and the corresponding portion of the thumbnail.... equivalent to and equated to the method for generating an enhanced thumbnail associated with a document, wherein the at least one visible element comprises first and second visible elements, further comprising determining relevance of the first and second elements, the first visible element being determined to have a higher

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relevance than the second visible element, wherein modifying the appearance of the at least one element comprises modifying the first visible element with a different modification than the second visible element of the '506 patent.

In addition, the difference between the applications is that the present application specifies a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail, whereas the '506 patent specifies the first and second visible elements, further comprising determining relevance of the first and second elements, the first visible element being determined to have a higher relevance than the second visible element, wherein modifying the appearance of the at least one element comprises modifying the first visible element with a different modification than the second visible element

The substantial similarity is drawn from the fact of displaying a document associated with a thumbnail generated based on an original document for enhancement in appearance as displayed on the thumbnail by of the '506 patent.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rohrbaugh et al US 20020091738A1**, CIP of 09/828,511 filed 07/07/2001, non-provisional of provisional 60/211,0169 filed 06/12/2000 (hereinafter Rohrbaugh), in view of Printed Publication by **Harry et al.** "Browsers with Changing Parts: a Catalog Explorer for Philip Glass' Website." Published August, 2000- US (hereinafter Harry).

Regarding **independent claim 1**, Rohrbaugh teaches:

displaying the thumbnail corresponding to an original document.

(See Rohrbaugh at page 6, paragraph 68, discloses a method and apparatus for supporting resolution independent vector wherein the HTTP carrier over TCP that allows a server to push image thumbnails to the client before SVF (Simple Vector Format) stream is available.

displaying a first version of the original document, and including an enhancement in appearance as display on the thumbnail, receiving a request to display the original document.

Also, see Rohrbaugh fig. 4b and also para 80, teaching the location of each object on a display page will be dependent on previous HTML layout elements, such as tables, paragraphs, line breaks, and other graphic objects. For example graphic objects #2-12 shows the graphic object #12 is dependent on previous HTML layout elements of graphic object #2 and so on. Using the broadest reasonable interpretation, Examiner equates the claimed **a first version and including an enhancement in appearance** as equivalent to objects #2-12 shows the graphic object #12 is dependent on previous HTML layout elements of graphic object #2 as taught by Rohrbaugh in fig. 4b.

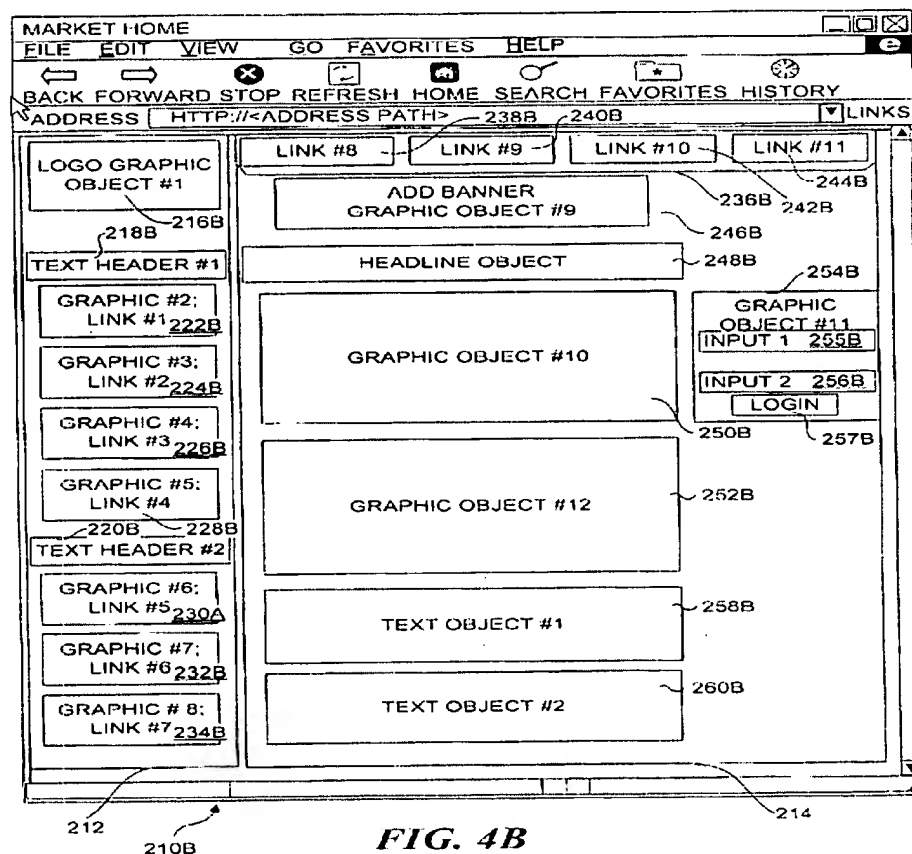


FIG. 4B

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In addition, Rohrbaugh does not explicitly teach, but Harry teaches:

displaying a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document based on comparison of the at least a portion of the first version to the corresponding portion of the original document and the corresponding portion of the thumbnail.

(See Harry at page 105, the Introduction section 1 and page 108 section 4.4 Zoomable Space, teaching the web browser with the visualization of semantic zooming utilizing the GlassEye overview as thumbnail of the applet viewer as shows in fig. 4.

Also, see Harry pages 109-110 fig. 3-4 section 5.1 Zooming for Detail, teaching the magnification of area of interest. Using the broadest reasonable interpretation, Examiner equates the claimed **the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion** as equivalent to visualization of semantic zooming wherein the area of interest is being magnified as taught by Harry.

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Applet Viewer glassEye class

Applet

Instrumentation Finder: Year & # of Instruments

Search Submit Clear Magnification Reset Magnification ☐ Zoom on Mouse Over

Formats ☐ CD ☐ Real Audio ☐ MP3 ☐ MIDI ☐ Sheet Music ☒ Show Grid ☐ Play Music ☒ Fill Dots

Categories ☒ Stage Works ☒ Chamber Orchestra ☒

↑ Satyagraha

Instruments: 15
Mood: 33
Intensity: 70
Popularity: 3
Length: 180 minutes

1980

The figure of Mohandas K. Gandhi shines so compellingly through the history of the twentieth century that one is apt to lose sight of the real subjects of Philip Glass' opera...

Related Works:

Premiere: September 5, 1980 in Rotterdam

Einstein on the Beach

Actors: Constance DeJong

Act III, Stuttgart

Year

Popularity

Length

Warning: Applet Window

Applet started.

Figure 4: Detailed display for a specific composition.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Rohrbaugh's resolution independent vector (i.e. SVG Simple Vector Format) to allow document to be independently scaled (i.e. zoom) larger and smaller at only a portion of the display screen will actually be used to display content, to including a means of enhancement in appearance as display on the thumbnail, to includes displaying a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document based on comparison of the at least a portion of the first version to the corresponding portion of the original document and the corresponding portion of the thumbnail as taught by Harry. One of ordinary skill in the art would have been motivated to perform such a modification to provide user the improved visual ability for reading small text or hard to see small images for displaying if internet content on small ratio devices, such as cell phones and hand help computers (see Rohrbaugh page 1 paragraph [0008]).

Regarding **independent claim 6**, the rejection of claim 1 is fully incorporated.

In addition, claim 6 is directed to an apparatus, includes **a display device and a controller** to perform the method of claim 1 which cited above, and is similarly rejected under the same rationale.

(See Rohrbaugh at page 11, paragraph 0101, also see Fig 7A-B and 9A-B) discloses scaling and offsetting content directly by the client user-interface software for PDA's, which provides additional functionality. For instance, a user may select to view a column (results represented in

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FIG. 7B by tapping that column with a stylus, as shown in FIG. 7A. Similarly, the user may select to zoom in on an image by tapping the image with the stylus, as shown in FIGS. 8A and 8B, or select to view a paragraph in an article by tapping on the paragraph, as shown in FIGS. 9A and 9B.

Regarding **claims 2-3**, Rohrabough does not explicitly teach, but Harry teaches:

displaying a second version of the original document in which a portion corresponding to the at least a portion of the first version is more similar to the corresponding portion of the original document, wherein the second version is substantially identical to the original document.

(See Harry at page 105, the Introduction section 1 and page 108 section 4.4 Zoomable Space, teaching the web browser with the visualization of semantic zooming utilizing the GlassEye overview as thumbnail of the applet viewer as shows in fig. 4.

Also, see Harry pages 109-110 fig. 3-4 section 5.1 Zooming for Detail, teaching the magnification of area of interest. Using the broadest reasonable interpretation, Examiner equates the claimed **a second version of the original document in which a portion corresponding to the at least a portion of the first version** as equivalent to visualization of semantic zooming wherein the area of interest is being magnified as taught by Harry.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Rohrabough's resolution independent vector (i.e. SVG Simple Vector Format) to allow document to be independently scaled (i.e. zoom) larger and

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smaller at only a portion of the display screen will actually be used to display content, to including an enhancement in appearance as display on the thumbnail, to includes a means of displaying a second version of the original document in which a portion corresponding to the at least a portion of the first version is more similar to the corresponding portion of the original document as taught by Harry. One of ordinary skill in the art would have been motivated to perform such a modification to provide user the improved visual ability for reading small text or hard to see small images for displaying if internet content on small ratio devices, such as cell phones and hand help computers (see Rohrabough page 1 paragraph [0008]).

Regarding **claim 4**, Rohrabough teaches:

wherein the corresponding portion of the thumbnail comprises an element modified during generation of the thumbnail.

(See Rohrabough at page 6, paragraph 68, discloses a method and apparatus for supporting resolution independent vector wherein the HTTP carrier over TCP that allows a server to push image thumbnails to the client before SVF (Simple Vector Format) stream is available.

Also, see Rohrabough fig. 4b and also para 80, teaching the location of each object on a display page will be dependent on previous HTML layout elements, such as tables, paragraphs, line breaks, and other graphic objects. For example graphic objects #2-12 shows the graphic object #12 is dependent on previous HTML layout elements of graphic object #2 and so on.

Regarding **claim 5**, is directed to a storage medium for performing the method of claim 1, and is similarly rejected along the same rationale.

Regarding **claims 7-8**, the rejection of claims 2-3 are fully incorporated, and are similarly rejected along the same rationale.

8. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Response to Argument

9. Applicant's arguments filed 1-30-2007 have been fully considered but they are not persuasive. Beginning on page 1 of 5 the REMARKS (hereinafter Remarks), Applicant argues the following issues, which are accordingly addressed below.

Regarding nonsatutory obviousness-type double patent rejection to claims 1-8: (Remarks, page 3 top-half).

Applicant argues that “**none of the claims of the '506 patent recites displaying a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document based on comparison of**

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the at least a portion of the first version to the corresponding portion of the original document and the corresponding portion of the thumbnail, as recited in claim 1 of the present application.”

The Examiner disagrees.

As discuss in the rejection above, it is obvious that the claimed limitation cites above, discloses a method of presenting a user an enhanced thumbnail associated with a document, wherein displaying a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document based on comparison of the at least a portion of the first version to the corresponding portion of the original document and the corresponding portion of the thumbnail.... equivalent to and equated to the method for generating an enhanced thumbnail associated with a document, wherein the at least one visible element comprises first and second visible elements, further comprising determining relevance of the first and second elements, the first visible element being determined to have a higher relevance than the second visible element, wherein modifying the appearance of the at least one element comprises modifying the first visible element with a different modification than the second visible element of the '506 patent.

In addition, the difference between the applications is that the present application specifies a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail, whereas the '506 patent specifies the first and second visible elements,

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further comprising determining relevance of the first and second elements, the first visible element being determined to have a higher relevance than the second visible element, wherein modifying the appearance of the at least one element comprises modifying the first visible element with a different modification than the second visible element

The substantial similarity is drawn from the fact of displaying a document associated with a thumbnail generated based on an original document for enhancement in appearance as displayed on the thumbnail by of the '506 patent.

This is an obviousness-type double patenting rejection because "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARRLABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001). "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "**anticipated**" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller,

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397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting.” (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

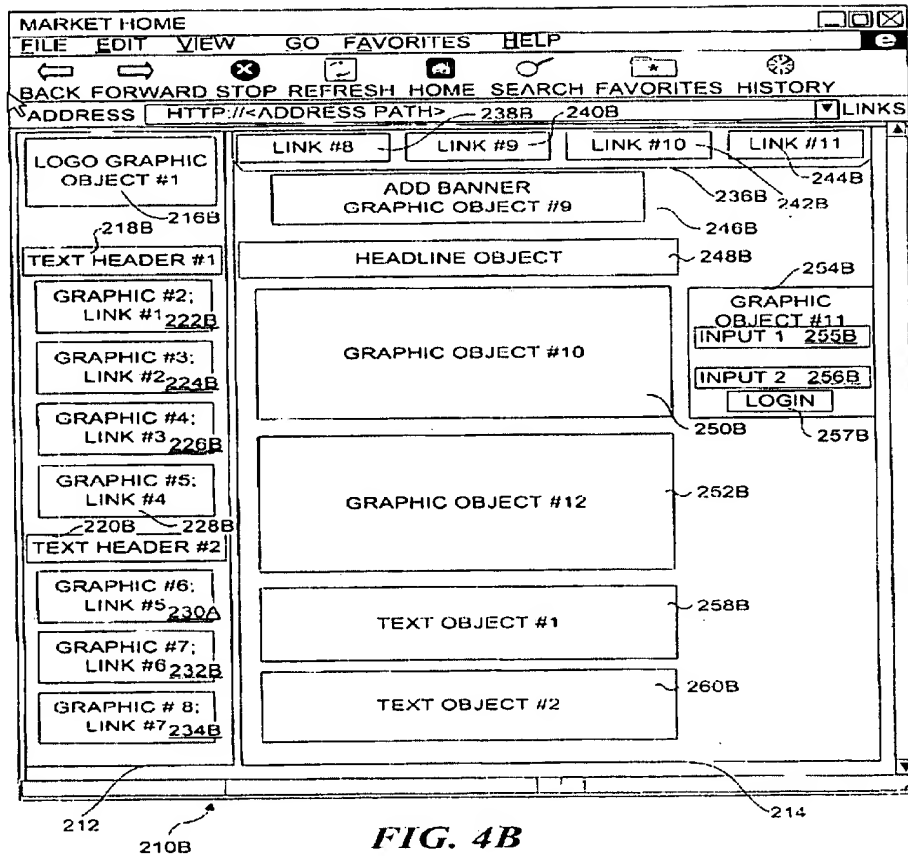
Regarding claims 1-8: (Remarks, pages 3-5).

Applicant argues that Rohrbaugh does not teach " **displaying a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document based on comparison of the at least a portion of the first version to the corresponding portion of the original document and the corresponding portion of the thumbnail.**"

The Examiner disagrees.

As discuss in the rejection above, Specifically, **Rohrbaugh** discloses the location of each object on a display page will be dependent on previous HTML layout elements, such as tables, paragraphs, line breaks, and other graphic objects. For example graphic objects #2-12 shows the graphic object #12 is dependent on previous HTML layout elements of graphic object #2 and so on. Using the broadest reasonable interpretation, Examiner equates the claimed **a first version and including an enhancement in appearance** as equivalent to objects #2-12 shows the graphic object #12 is dependent on previous HTML layout elements of graphic object #2 as taught by Rohrbaugh in fig. 4b. Also, see Rohrbaugh fig. 4b and also para 80,

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**FIG. 4B**

In addition, to address the amended portions:

Examiner introduces Harry reference, as discussed in the rejection above. Specifically, Harry discloses the web user interface embedded therein a visualization semantic zooming that utilizing the GlassEye overview as thumbnail of the applet viewer as shown in fig. 4 (See Harry at page 105, the Introduction section 1 and page 108 section 4.4 Zoomable Space).

Also, see Harry pages 109-110 fig. 3-4 Section 5.1 Zooming for Detail, teaching the magnification of area of interest. Using the broadest reasonable interpretation, Examiner equates the claimed **the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion** as equivalent to visualization of semantic zooming

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wherein the area of interest is being magnified as taught by Harry. (See Harry at page 105, the Introduction section 1 and page 108 section 4.4 Zoomable Space, Also, see Harry pages 109-110 fig. 3-4 section 5.1 Zooming for Detail.

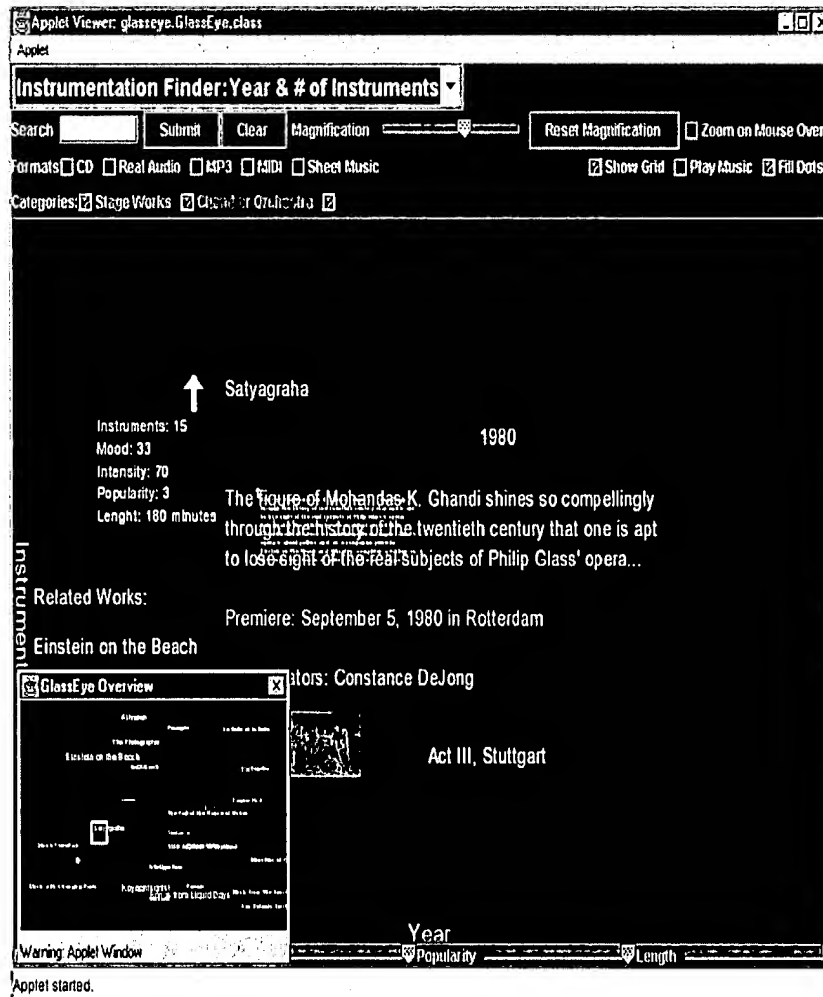


Figure 4: Detailed display for a specific composition.

For at least all the above evidence, therefore the Examiner respectfully maintains the rejection of claims 1-8 at this time.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM EST.

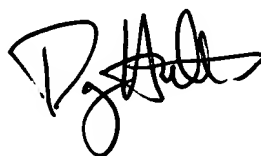
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R. Heather can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Quoc A. Tran
Patent Examiner
Technology Center 2176
April 25, 2007



Doug Hutton
Primary Examiner
Technology Center 2100